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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/764,107	01/19/2001	Teturo Tanno	202108US0	4524

22850 7590 03/10/2003

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1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER

CAIN, EDWARD J

ART UNIT	PAPER NUMBER
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1714

DATE MAILED: 03/10/2003

12

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/764,107

Applicant(s)

Tanno et al

Examiner

Edward Cain

Group Art Unit

1714

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 11/27/02
- ☒ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-31 is/are pending in the application.
- Of the above claim(s) 2-5 is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☐ Claim(s) 1, 6-8, 10, 13, 15-18, 20, 22-25, 27, 29-31 is/are rejected.
- ☒ Claim(s) 9, 11, 12, 14, 19, 21, 26, and 28 is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____.
 - ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

Office Action Summary

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1. The amendment received November 29, 2002 has been made of record, claim 1-31 are pending. Claim 2-5 are withdrawn from consideration claim 1, and 6-31 are being examined

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1, 18 and 25 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Each of the rejected claims contains a negative limitation to the cross linking agent. The examiner cannot find support in the application as originally filed for language which explicitly excludes any particular crosslinker.

4. Claims 1, 6-8, 10,13,15-18, 22,22-25, 27 and 29-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rau et al or Suzuki et al or Mayer et al.

This rejection is maintained for reasons of record.

Applicants have traversed each of the references based on arguments concerning the lack of disclosure of crosslinking agents other than polyisocyanates. However, since this newly added limitation is seen as new matter these arguments are not seen as persuasive.

Applicant has additionally argued that each of the references fails to disclose applicant claim antifoam additive or the amounts claimed instantly. Regarding amounts, it is the position of the examiner that it is within the scope of ordinary skill in the art to select such amounts in order to achieve the desired antifoam properties.

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Regarding applicant's allegation that Suzuki fails to teach antifoam agents as an additive to these undercoat compositions, applicant's attention is directed to columns 7, line 2 of Suzuki.

Applicants have further argued that Suzuki teaches away from applicants claimed amounts of dispersant by distinguishing parts by weight from weight per cent. Applicants attention is directed to the fact that Suzuki bases, parts by weight on weight of monomer, not the total weight of composition and is, therefore, equivalent to applicants parts by weight.

5. Claims 9, 11, 12, 14, 19, 21, 26, and 28 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edward Cain whose telephone number is 703-308-0042. The examiner can normally be reached on M-F from 10:00 to 6:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vase Jagannathan, can be reached on (703) 306-2777. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edward Cain whose telephone number is 703-308-0042. The examiner can normally be reached on Monday-Friday from 10:00am to 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vase Jagannathan can be reached on 703-306-2777. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9097 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

Cain/fk
March 6, 2003

